

REMARKS

1. Rejections under 35 U.S.C. 101

Claims 1-15 and 21-23 were rejected as being directed to non-statutory subject matter. Independent claim 1, from which claims 2-15 depend, is currently amended to distinctly claim the steps of publishing the database, and also of a user locating a cellular number by searching the database. (The Applicant notes that the amended language of claim 1 is introduced in response to the Examiner's 35 U.S.C. 101 rejection, and not to distinguish over any reference cited by the Examiner.) The amended language is supported in the disclosure (see, for example, page 6, lines 10-20). Compiling multiple lists into a database, and publishing the database, achieves a useful, concrete, and tangible result. Furthermore, locating a previously-unknown cellular number as a result of the claimed method also achieves a useful, concrete, and tangible result. The Applicant respectfully submits that the methods claimed in claims 1-15, as currently amended, result in concrete and tangible results and therefore constitute statutory subject matter.

Applicant further notes that newly-amended independent claim 21 claims the method of compiling a list of cellular phone numbers, and providing at least one of a phone book, a CD-ROM, and an electronic network including the compiled list. This method transforms cellular phone numbers into a list of such numbers, and further transforms the list into a portion of at least one of a phone book, a CD-ROM, and an electronic network provided to phone users. Applicant respectfully submits that providing a phone book, a CD-ROM,

or an electronic network that includes a list of cellular numbers satisfies the statutory requirement by resulting in a useful, concrete and tangible result.

Similarly, newly-amended independent claim 22, from which claim 23 depends, claims the method of compiling a list of wireless type phone numbers, and providing at least one of a phone book, an electronic network, and a CD-ROM including the compiled list. This method transforms wireless type phone numbers into a list of such numbers, and further transforms the list into a portion of at least one of a phone book, CD-ROM, or electronic network provided to phone users. Applicant respectfully submits that providing a phone book that includes a list of wireless type phone numbers also satisfies the statutory requirement by resulting in a useful, concrete and tangible result.

2. Rejections under 35 U.S.C. 112, Second Paragraph

The Examiner asserts claims 4, 9, 20, and 21-23 fail to particularly point out and distinctly claim the invention. In particular, the Examiner asserts that it is unclear what is intended by "phone book" or by "unpublished."

The term "phone book" is well-known as meaning a physical printed directory comprising indexed phone numbers. Support for this interpretation is found in the Background of the Invention, which distinguishes the term from other sources of phone number information, such as internet directories and operator-assisted calls, and provides as examples the well-known Yellow Pages and White Pages (pg. 1, ln. 11 - pg. 2, ln. 6). This common interpretation is further supported by Applicant's distinguishing of a printed phone book from other methods

of making phone information available to users: "the... alphabetical directory may be published in a phone book, on CD-ROM, in an electronic network (such as the internet), as part of an operator-assisted dial-in service..." (pg. 7, ln. 14-17). Applicant further directs the Examiner's attention to claims 3-5, which distinguishes the physical publication of a phone book from electronic publication such as via CD-ROM or electronic network.

The Applicant uses the terms "published" and "unpublished" in two contexts in the present application. The first context is in connection with methods of making the database available to users, and in this context the term "published" may be used interchangeably with the phrase "made available to users." Support for this interpretation is found in the disclosure: for example, "The database or alphabetical directory may be published in a phone book, on CD-ROM... or by some other means which allows a user to conveniently search the database" (pg. 7, ln. 14-18).

The second context in which "published" and "unpublished" is used is in connection with individual phone numbers, and in this context the term "unpublished" may be used interchangeably with "unlisted." Support for this interpretation is also found in the Disclosure: for example, "phone users that do not want to provide public access to their corresponding cellular phone numbers may request that their numbers be unpublished... in order to prevent [their numbers] from being accessed" (pg. 8, ln. 4-6).

The Applicant respectfully submits that the meanings of the terms "phone book" and "published" are consistent with ordinary usage and such usage is supported by

Applicant's disclosure, and therefore satisfy the requirements of 35 U.S.C. 112, second paragraph.

3. Rejections under 35 U.S.C. 112, First Paragraph

The Examiner asserts claims 4, 9, 20, and 21-23 fail to comply with the enablement requirement. In particular, the Examiner asserts that there is no support in the Disclosure for a phone book and the means to provide it, and that there is no support in the Disclosure for publishing in any of a variety of modes.

As noted above in Applicant's response to the Examiner's rejection under 35 U.S.C. 112, second paragraph, the term "phone book" designates a physical printed directory comprising indexed phone numbers. Applicant uses as examples the well-known Yellow Pages and White Pages in the Background of the Invention (pg. 2, ln. 2-6). Applicant respectfully submits that producing a printed book containing phone numbers is a well-understood and mature technology, and that the examples of the Yellow Pages and the White Pages provided by Applicant are sufficient to enable one of ordinary skill in the art to practice the invention of claims 4 and 21-23.

Also noted above in Applicant's response to the Examiner's rejection under 35 U.S.C. 112, second paragraph, the term "unpublished" used in connection with phone numbers, as in claims 9 and 20, is to be interpreted as "unlisted," in contrast to Applicant's use of "published" in connection with making a database of phone numbers available to users. Claims 9 and 20 recite actions to be taken in response to unpublished cellular phone numbers. Phone numbers may be designated unpublished at the users' request: "phone users that do not want to provide public

access to their corresponding cellular phone numbers may request that their numbers be unpublished... in order to prevent [their numbers] from being accessed" (pg. 8, ln. 4-8).

Claim 9 recites the steps of tagging numbers as unpublished at the users' request, and removing the unpublished numbers from the list. These steps are supported by the disclosure (pg. 6, ln. 13-21). The Applicant respectfully submits that operations for designating and removing a database record from a database are well known in the field of computer science, and that Applicant's disclosure is sufficiently enabling to allow one of ordinary skill in the art to practice the claimed invention.

Similarly, Claim 20 recites the step of generating a message that a number is unpublished. The Applicant respectfully submits that the generation of a particular message corresponding to database query is well known in the art, and that Applicant's disclosure is sufficiently enabling to allow one of ordinary skill in the art to practice the claimed invention.

4. Rejections under 35 U.S.C. 102

Claims 1 and 10, which depends from claim 1, were rejected under 35 U.S.C. 102(e) as being anticipated by Czyszczewski et al (Czy). However, the contact database of Czy fails to teach or suggest pertinent features of the present invention.

Applicant respectfully directs the Examiner's attention to Applicant's claimed step of "compiling a list of cellular phone users from at least one cellular phone

provider" (emphasis added). The feature of compiling a list of users from a cellular phone provider is not shown or suggested in Czy. Instead, the contact database of Czy is populated by individual users of the system of Czy [COL 7 lines 35-40]. The user of the Czy system uses a device such as a PC or PDA to create and maintain their user contact information, and uploads the contact information to the contact database for later reference [COL 7, lines 37-38; COL 10, lines 47-63; COL 12, lines 9-13]. There is no teaching, motivation, or suggestion of performing the Applicant's claimed step of compiling a list of numbers from a cellular provider.

A user of the system of Czy first creates a personal contact list, which may contain cellular phone numbers, and then loads the personal contact list into the Czy system for future reference. However, cellular phone numbers can be difficult to obtain because of the need recognized by the Applicant for a publicly-accessible database providing cellular phone users listed with their corresponding cellular phone numbers. A user of the system of Czy would continue to face this difficulty. Applicant notes that Applicant's claimed invention provides such a user-accessible database, and that Applicant's claimed invention may assist in forming the user contact information that is uploaded into the system of Czy.

Because Czy does not teach Applicant's feature of compiling a list of cellular users from a cellular provider, and instead teaches each user's contact information is compiled and maintained by the individual users, Applicant respectfully submits that Czy neither anticipates nor renders obvious Applicant's claimed invention.

5. Rejections under 35 U.S.C. 103(a)

Claims 2-9 and 11-23 were rejected under 35 U.S.C. 103(a) as being obvious over Czyszcwski (Czy) in light of Talib et al. However, as noted above, Czy teaches that each user's contact information is created and maintained on their personal devices such as a PC or PDA and uploaded to a contact database for later access. Czy thus does not anticipate or suggest the feature of Applicant's claim 1, from which claims 2-15 depend, of compiling a list of cellular users from a cellular provider.

The combination of Talib with Czy similarly does not overcome the failure of Czy to provide a teaching, motivation, or suggestion of compiling a list of cellular users from a cellular provider. Talib teaches a complex method of database indexing and search techniques requiring multiple independent hierarchical category taxonomies for locating a provider of desired goods or services in a database. However, Talib fails to teach or suggest Applicant's claimed step of compiling a list of cellular users from a cellular provider.

Applicant acknowledges that advertisers may provide cellular phone numbers as part of an advertisement in a phone directory (pg. 2, ln. 2-3). However, Talib only teaches that each advertiser's contact information is provided by the advertiser individually [0149; 0156; 0173] with no teaching or suggestion to acquire cellular user names or numbers from a cellular provider. Therefore, Talib teaches away from Applicant's claimed invention by having each advertiser provide its own contact information

(which may include a cellular number), rather than being included in a list compiled from a cellular provider.

Because Czy and Talib, either alone or in combination, fail to anticipate or render obvious the method claimed in Applicant's claim 1, claims 2-15 which depend from claim 1 similarly cannot be rendered obvious by either reference alone or in combination.

Applicant's claims 16-20, directed to a system having program instructions that implement the steps of claim 1, similarly cannot be rendered obvious by Czy in combination with Talib for the same reasons recited for method claims 2-15.

Finally, Applicant's newly amended claims 21 and 22, from which claim 23 depends, also incorporate the feature of compiling a list of numbers from a provider to further patentably distinguish from the cited art for the same reasons discussed above, and therefore cannot be rendered obvious by the combination of Talib with Czy. The Applicant notes that the amended language of claims 21 and 22 introducing the Markush group is not introduced to distinguish over any reference cited by the Examiner.

In conclusion, Applicant respectfully submits that Applicant's claimed invention is deserving of patent protection because it describes a useful and functional method and system which patentably distinguishes over the cited prior art. Applicant respectfully submits that this Amendment is fully responsive to all aspects of the rejections tendered by the Examiner in the subject Office Action. Accordingly, Applicant respectfully submits that he has persuasively demonstrated that the above-identified Patent Application is in condition for allowance. Such action is earnestly solicited.

If there are any fees incurred by this Amendment Letter, please deduct them from our Deposit Account No. 23-0830.

Respectfully submitted,

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